

U.S. Serial No. 09/748,609

Filed: December 26, 2000

Defective Appeal Brief

The Examiner has objected to the arguments in Appellants brief related to an alleged new matter objection made by the Examiner in the office action mailed on December 23, 2002 and reiterated in the office action mailed July 17, 2003.

Claims 9-12 were rejected in an office action mailed on August 9, 2002 pursuant to 35 USC §112 first paragraph as being based on a non-enabling disclosure. Claims 9-12 remained rejected for this reason. In an effort to overcome the rejection of claims 9-12 pursuant to 35 USC §112 first paragraph, Applicant amended the specification to include a new paragraph between paragraphs 46 and 47 on page 10 and added new Figure 6 (see office action response mailed on November 8, 2002).

The new paragraph and Figure 6 have not been considered by the Examiner with regard to the rejection of Claims 9-12 but even more clearly overcome the rejection pursuant to 35 USC §112 first paragraph. Accordingly, the alleged new matter directly affects Claims 9-12 and is therefore appealable pursuant to MPEP 608.04(c) which reads:

608.04(c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. 37 CFR 1.181 and 37 CFR 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

Applicant clearly indicated that the alleged new matter directly affected Claims 9-12 in the original Appeal Brief filed via first class mail on June 12, 2003, and again in the Supplemental Appeal Brief filed on October 16, 2003. Applicant respectfully asserts that neither the original Appeal Brief or the Supplemental Appeal Brief are defective since the alleged new matter directly affects the rejection of Claims 9-12. Accordingly, pursuant to 37

U.S. Serial No. 09/748,609

Filed: December 26, 2000

CFR 1.181 and 37 CFR 1.191, Applicant respectfully requests that all the issues raised in the Supplemental Appeal Brief continue on appeal.

The Examiner has further noted in this Office Communication that the specification does not enable how to make and use the circuit of new Fig. 6. As indicated by the Declaration of Mr. James Wordinger, and discussed at length in the Appcal Brief filed June 12, 2003 and the Supplemental Appeal Brief filed October 16, 2003, those skilled in the art would interpret the spccification and other drawings to support new Fig. 6.

No fees are believed to be required at this time. However, should any fees be deemed necessary, please charge such fees to Deposit Account No. 23-1925. Should the Examiner deem a telephone conference to be beneficial, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,



Sanders N. Hillis

Attorney Reg. No. 45,712
CUSTOMER NO. 27879

(317) 363-0886
(317) 634-6701 (fax)